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In re Application of:
Tsutsui et al.
Serial No.: 10/674,581
Filed: September 29, 2003
Attorney Docket No.: 019941-001810US

: PETITION DECISION

This is in response to the petition under 37 CFR § 1.181, filed November 9, 2007, requesting withdrawal of finality of the Office action of October 5, 2007.

BACKGROUND

More recently, the examiner mailed a final Office action on May 29, 2007 setting a three month shortened statutory period for reply. In this Office action, the examiner rejected claims 1-4, 7-10, 13-16 and 19 under 35 USC § 103(a) as being obvious over Staats et al. (WO 00/20028) in view of Takasu (Kurume Med J., 2001, Vol. 48, pp. 171-174) and rejected claims 1-4, 7-10, 13-16 and 19 under 35 USC § 103(a) as being obvious over Foster (US 6,436,391) in view of Tovey (US 6,361,769). The examiner additionally maintained the withdrawal of claims 21-27 from consideration on the merits for being directed toward a non-elected invention.

In response to the final Office action of May 29, 2007, applicants filed an RCE on August 29, 2007 which included an amendment to the claims and remarks. Applicants cancelled claims 5-6, 8, 10, 14 and 16 and added new claims 31-39. Applicants amended claims 7, 13 and 19 to newly recite 'a natural' interferon α and to insert the language 'wherein said vaccine antigen comprises a protein or peptide antigen' (or 'and wherein said vaccine antigen comprises a protein or peptide antigen' in the case of claim 19). These limitations added by the amendment were already considered and examined prior to the filing of the RCE, as these limitations were previously present in claims 5-6, 8, 10, 14 and 16.

The examiner mailed a final Office action on October 5, 2007 setting a three month shortened statutory period for reply. In this Office action, the examiner maintained the rejection of claims 7, 9, 13, 15 and 19 under 35 USC § 103(a) as being obvious over Staats et al. (WO 00/20028) in view of Takasu (Kurume Med J., 2001, Vol. 48, pp. 171-174) and additionally rejected new claims 31-39 under 35 USC § 103(a) as being obvious over Staats et al. (WO 00/20028) in view

of Takasu (Kurume Med J., 2001, Vol. 48, pp. 171-174). The examiner maintained the rejection of claims 7, 9, 13 and 19 under 35 USC § 103(a) as being obvious over Foster (US 6,436,391) in view of Tovey (US 6,361,769) and additionally rejected new claims 31-39 as being obvious over Foster (US 6,436,391) in view of Tovey (US 6,361,769). The examiner maintained the withdrawal of claims 21-27 as being directed toward a non-elected invention.

In response thereto, applicants filed this petition requesting reconsideration and removal of the finality of the Office action of October 5, 2007.

DISCUSSION

Applicants argue that the final Office action of October 5, 2007 is premature because the amendment submitted on May 29, 2007 does not meet the requirements for making a first Office action on the merits final according to the MPEP.

Specifically, applicants cite the MPEP § 706.07(b):

> [the] claims of a new application may be finally rejected in the first Office action in those situations where...(B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Applicants argue that "...all claims of the new application(1) are **NOT** drawn to the same invention claimed in the earlier application, and therefore, the finality of the Office Action dated October 5, 2007 is clearly premature" (emphasis in applicants' original remarks). Applicants subsequently request removal of the finality of the Office action dated October 5, 2007.

The MPEP § 1208.01 provides the following description of 'new ground of rejection':

> There is no new ground of rejection when the basic thrust of the rejection remains the same such an *appellant has been given a fair opportunity to react to the rejection*...Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection.

Applicants' points are well taken and it is decided that claims 31-39 are not the same invention which the examiner considered prior to the filing of the RCE on August 29, 2007. As evidence thereof, claims 31-39 required a new consideration on the merits by the examiner which necessitated the need to reject claims 31-39 for a new reason based upon a new issue of inherency. Thus, it is determined that the examiner raised a new ground of rejection in the final Office action of October 5, 2007, thereby prohibiting finality of the Office action in accordance with MPEP § 706.07(b). It is decided that applicants have not been given a fair opportunity to counter the examiner's reasoning for rejecting claims 31-39.

Applicants' arguments are persuasive that the final Office action issued October 5, 2007 was premature and the finality of the Office action will be withdrawn.

DECISION

The petition is **GRANTED.**

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

Christopher Low
Acting Director, Technology Center 1600